

REMARKS

AMENDMENTS TO THE SPECIFICATION

- 5 Page 9 has been further amended in the way suggested by the Examiner.

AMENDMENTS TO THE CLAIMS

 New claims 74-82 have been added. Basis for claim 74 is in claim 1.

- 10 [paragraphs (1), (2), (a), (b), (c) and (d) (v)]; page 5, lines 17-18 (for the use of mixtures of polymers); and page 9, line 5 (for a crystalline melting point greater than 40°C).
Basis for claim 75 is on page 3, lines 3-4. Basis for claim 76 is on page 5, lines 3-4.
Basis for claims 77-82 is on page 9, lines 28-34.

- 15 It is submitted that new claims 74-76 can properly be added, even if the finality of the office action is maintained, since these claims are directed to compositions in which the SCC polymer consists of one or more SCC polymers each of which has a melting point greater than 40°C and is substantially free of functional groups. This is clearly different from anything disclosed or suggested by Mueller or Morawsky. Mueller
20 requires that his additive should contain not only a polyalkyl(meth)acrylate having an onset of crystallization at a temperature above 15 °C, but also a polyalkyl(meth)acrylate having an onset of crystallization at temperatures at or below 15 °C; furthermore, Mueller explicitly warns that either of these two ingredients, if used without the other, will be "ineffective... or rather poorly effective" (column 2, lines 17-20). An essential feature
25 of Morawsky's additives is that they should contain carboxyl groups.

- It is submitted that new claims 77-82 can properly be added, even if the finality of the office action is maintained, since these claims are directed to specific embodiments of the cosmetic compositions claimed in claims 40 and 45, and thus do not raise any
30 new issues for consideration by the Examiner.

THE OBJECTIONS AND REJECTIONS

The Objection under 35 U.S.C. 132.

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The objection under 35 U.S.C. 132 has been rendered moot by the amendment to the specification.

The Provisional Double Patenting Rejection

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Applicants will address the issues raised by the provisional double patenting rejection when the claims of this application and Application Serial No. 09/398,377 are otherwise in condition for allowance.

15 The Rejections under 35 U.S.C. 102 and 35 U.S.C. 103

Applicants respectfully traverse

- 20 (1) the rejection of claims 40-42 and 44-50 under 35 U.S.C. 102 as anticipated by Mueller (U.S. Patent No. 5,281,329) with Morawsky (U.S. Patent No. 5,736,125) as a teaching reference, and
- (2) the rejection of claims 40-42 and 44-50 under 35 U.S.C. 103 as unpatentable over Mueller in view of Morawsky,
- insofar as those rejections can be understood, for the following reasons.

25 The Rejection under 35 U.S.C. 102

Applicants traverse the rejection under 35 USC 102 for the reasons which are set out in full in the Reply mailed June 17, 2003, and which, in the interests of brevity, are incorporated herein by reference rather than repeated verbatim. In addition, the

30 Examiner's attention is drawn to the attached Declaration by Dr. Bitler. This Declaration

affirms the following propositions which have been previously set out, and which are believed to be apparent from the papers previously of record;--

(a) the procedures set out in Mueller will make the petroleum oils flow more easily, i.e. will make the oils thinner, not thicker; and

5 (b) Mueller does not disclose or suggest any cosmetic composition;

(c) the SCC polymers used as additives by Mueller do not contain carboxyl groups;

(d) the SCC polymers used as additives in Morawsky must contain carboxyl groups; and

10 (e) one of ordinary skill in the art of cosmetic compositions, reading Morawsky, would understand that the numerical range of 0.1-12% disclosed by Morawsky is a range within which effective concentrations are likely to be found; that concentrations within the range of 0.1-12% will not necessarily be effective; and that, in some cases, effective concentrations will be outside the range of 0.1-12%; and

15 (f) the amounts of additive likely to be used in practicing Mueller's invention are much smaller than the amounts likely to be used in practicing Morawsky's invention or in practicing the present invention.

Dr. Bitler's declaration also explains that it seems likely, in view of (f), that at least some
20 SCC polymers will both (i) make at least some oils thinner when used in low concentrations, and (ii) make at least some oils thicker when used in much greater concentrations. Insofar as the Examiner's rejections depend upon the overlap of the broadest ranges disclosed in Mueller and Morawsky, Dr. Bitler's explanation may assist the Examiner in understanding the technical reasons for the fact, already established by
25 the documents themselves, that Mueller and Morawsky are intended to produce, and do in fact produce, opposite results.

Newly added Independent Claim 74, and claims 75 and 76 dependent on claim 74, newly added claims 77-79, dependent on claim 40, and newly added claims 80-82,
30 dependent on claim 45, claim additional compositions which are clearly distinguished from Mueller and Morawsky, as explained above.

The Rejections under 35 U.S.C. 103

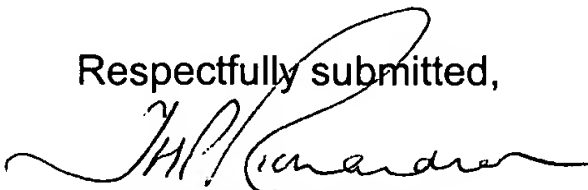
Applicants traverse the rejections under 35 USC 103 for the reasons which are set out in full in the Reply mailed June 17, 2003, and which, in the interests of brevity, are incorporated herein by reference rather than repeated verbatim. In addition, the Examiner's attention is drawn to the attached Declaration by Dr. Bitler, which is relevant for the same reasons as are explained above in connection with the rejection under 35 USC 102.

Newly added Independent Claim 74, and claims 75 and 76 dependent on claim 74, newly added claims 77-79, dependent on claim 40, and newly added claims 80-82, dependent on claim 45, claim additional compositions which are clearly distinguished from Mueller and Morawsky, as explained above.

CONCLUSION

It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted,



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